IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Leonard Speiser et al.   Examiner: Asfand M. Sheikh

Serial No.: 10/666,681   Group Art Unit: 3627

Filed: September 18, 2003   Docket: 2043.093US1

For: PRODUCT RECOMMENDATION IN A NETWORK-BASED COMMERCE SYSTEM

APPEAL BRIEF UNDER 37 CFR § 41.37

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Sir:

The Appeal Brief is presented in response to the Notice of Panel Decision from Pre-Appeal Brief Review dated November 4, 2009 and further in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed October 14, 2009, from the Final Rejection of claims 15-22 of the above-identified application, as set forth in the Final Office Action dated July 15, 2009.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of $540.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellants respectfully request consideration and reversal of the Examiner's rejections of pending claims.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

TABLE OF CONTENTS

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, EBAY INC., as evidenced by the Assignment from the Inventors recorded September 18, 2003 at Reel 014534, Frames 0163-0165.

2. RELATED APPEALS AND INTERFERENCES

There are no other Appeals or interferences known to Appellants that will have a bearing on the Board's decision in the present Appeal.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37
Serial Number: 10/666,681
Filing Date: September 18, 2003
Title: PRODUCT RECOMMENDATION IN A NETWORK-BASED COMMERCE SYSTEM

Page 4
Dkt: 2043.093US1

3. STATUS OF THE CLAIMS

The present application was filed September 18, 2003 with claims 1-34. In a response filed January 30, 2006 to a Non-Final Office Action dated November 16, 2005, Appellants cancelled claims 1-14 and 23-34. Claims 15-22 stand twice rejected, remain pending, and are the subject of the present Appeal.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action dated July 15, 2009.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Aspects of the claimed subject matter include, but are not limited to, product recommendations in a network-based commerce system. "The method includes identifying a division of the plurality of divisions based on user interaction with the network-based commerce system, and identifying at least one frequently used search term associated with the division. A link is provided to the user to listings associated with the frequently used search term." (U.S. Published Patent Application No. 2004/0078214, page 1, paragraph 0005, lines 4-9, emphasis added).

The following definitions are provided to facilitate understanding of the claimed subject matter. "The word '**term**' includes any criteria, textual, numeric, visual, audible or otherwise, **submitted by users** searching a network-based commerce system." (Published Application, page 2, paragraph 0026, lines 4-6, emphasis added). "Broadly, any **entry by a user into a search field** may thus define a **search** '**term**' or 'phrase'." (Published Application, page 2, paragraph 0026, lines 11-13, emphasis added).

INDEPENDENT CLAIM 15

15.   A method of providing listing recommendations to users of a network-based commerce system including a plurality of listings arranged in a plurality of divisions (Published Application, FIG. 11, item 180; page 5, paragraph 0069, lines 1-5), the method including:

> identifying a division of the plurality of divisions based on user interaction with the network-based commerce system (Published Application, FIG. 11, item 182; page 5, paragraph 0070, lines 1-5);

> **identifying at least one frequently used search term** associated with the identified division (Published Application, FIG. 11, item 186; page 6, paragraph 0083, lines 1-5; emphasis added); and

> **providing a link** to the user **to listings associated with the at least one frequently used search term** (Published Application, FIG. 11, item 188; page 6, paragraph 0084, lines 1-6, emphasis added).

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellants refer to each of the appended claims and its legal equivalents for a complete statement of the invention.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37
Serial Number: 10/666,681
Filing Date: September 18, 2003
Title: PRODUCT RECOMMENDATION IN A NETWORK-BASED COMMERCE SYSTEM

Page 8
Dkt: 2043.093US1

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

§ *102 Rejections of the Claims*

Claims 15-22 were rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Spiegel et al. (U.S. Patent No. 6,466,918, hereinafter "Spiegel").

7. ARGUMENT

A) The Applicable Law under 35 U.S.C. §102(b)

"A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed Cir. 1987), emphasis added. It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, **arranged as in the claim**." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983), emphasis added. Furthermore, "[t]he identical invention must be shown **in as complete detail** as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989), emphasis added. Accordingly, to anticipate a claim, a reference must teach **each and every element** of the claim, as arranged in the claim, and in as complete detail as in the claim, and "the exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference." *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771-72, 218 U.S.P.Q. 781, 789 (Fed Cir. 1983).

B) Discussion of the rejection of claim 15 under 35 U.S.C. § 102(b) as allegedly being anticipated by Spiegel.

Appellants respectfully submit that Spiegel does not establish a *prima facie* case of anticipation, because Spiegel fails to teach each and every element of Appellants' claims, as arranged in the claims, and in as complete detail as in the claims.

Independent claim 15 recites, in part, "**identifying** at least one **frequently used search term** associated with the identified division." In the Final Office Action dated July 15, 2009, the

Examiner cited FIG. 1A of Spiegel and "col. 4, lines 43-67; col. 6, lines 5-60; col. 7, lines 6-67; [and] col. 8, lines 33-59 " of Spiegel as allegedly disclosing this element. Final Office Action, page 4. The entirety of Spiegel, however, actually fails to disclose **identifying a frequently used search term**, as recited in the context of claim 15.

In the Final Office Action, the Examiner asserted that "the frequently-used search term "Olympics" [is] associated with the second identified division under "Featured Categories" in Figure [1A]." *Id.* at page 2. FIG. 1A of Spiegel actually depicts the phrase "Olympics (75 Bestsellers)" as one of three "Featured Categories" on a web page. Spiegel, FIG. 1A, item 110. The cited text of Spiegel explicitly states that "FIG. 1A illustrates an example Web page that includes . . . **featured** book **categories** 110 and featured book titles 120." *Id.* at column 7, lines 6-8, emphasis added. Spiegel explicitly explains that "the featured book categories and featured book titles are derived from the Sports & Outdoors branch of the browse tree." *Id.* at column 7, lines 8-11, quotation marks and reference numerals omitted, emphasis added. In fact, Spiegel specifically refers to "Olympics" as a "**category**." *Id.* at column 7, line 12, ("**the category "Olympics"** is featured . . . ."), emphasis added. Therefore, according to unambiguous language in Spiegel, the word "Olympics" shown in FIG. 1A of Spiegel is a title of a **category** that was derived from a branch of a browse tree.

A title of a **category** is not the same as a **search term**. Spiegel expressly states that "[m]any online merchants and other businesses group their products, services or other items into a set of categories and subcategories of a browse tree." *Id.* at column 1, lines 25-27. To those of ordinary skill in the art, a **category** that groups products, services, or other items does not constitute a **search term**. Accordingly, **deriving a category** from a branch of a browse tree is not the same as **identifying a search term**, much less **identifying a frequently used search term**.

Appellants note that Spiegel states, "Node popularity levels are . . . determined based on user activity data . . . [that] may include . . . the **number of searches** performed within each category." *Id.* at column 6, lines 16-24, emphasis added. A mere **number**, however, is not the

same as a **search term**. Moreover, a discussion of searches that are performed **within** a category does not disclose **identification of a frequently used search term**. Indeed, the phrase "**search term**" does not appear at all in Spiegel. Consequently, Spiegel is entirely silent with respect to a **search term** and **identification of a search term**.

In the Advisory Action dated October 7, 2009, the Examiner cited column 6, lines 40-60 of Spiegel as allegedly disclosing that "a category can be searched by a user." Advisory Action, page 2, lines 4-5, quotation marks omitted. Within column 6 of Spiegel, however, the only mention of "search" appears in lines 21-24, which are discussed above, and Appellants respectfully suggest that the Examiner's citation is in error. As noted above, mere mention of a **number** of searches fails to disclose a **search term**, let alone **identification of a frequently used search term**. Moreover, a discussion of searches performed **within** a category does not support any reasonable inference that such searches somehow constitute **identification of a frequently used search term**.

In the Advisory Action, the Examiner also pointed to column 6, lines 21-29 of Spiegel as allegedly disclosing that "category data nodes includes [sic] data related to activity with the category." *Id.* at page 2, line 6. Spiegel, however, does not use the phrase "data node" or "category data node" anywhere. As noted above, Spiegel states that "[n]**ode popularity levels** are . . . determined based on user activity data . . . ." Spiegel, column 6, lines 16-17, emphasis added. Mere discussion of determining a node's popularity level based on user activity data does not disclose **identification of a frequently used search term**.

Moreover, Spiegel contains no discussion whatsoever of **frequency of use** with respect to a **search term**. As a result, nothing in Spiegel discloses **identifying a frequently used search term**, much less identifying a frequently used search term that is associated with an identified division, as recited in the context of claim 15. Thus, Spiegel fails to disclose at least this element of claim 15.

Furthermore, independent claim 15 recites, in part, "**providing a link** to the user **to listings associated with the** at least one frequently used **search term**." In the Final Office Action, the Examiner cited "Figure 1" of Spiegel and "column 4, lines 61-67" of Spiegel as allegedly disclosing this element. Final Office Action, page 3. The entirety of Spiegel, however, actually fails to disclose **providing a link to listings associated with a search term**, as recited in the context of claim 15.

In the Final Office Action the Examiner asserted that "the items/listings shown in Figure [1A] are hyperlinks." *Id.* As noted above, "FIG. 1A [of Spiegel] illustrates an example Web page that includes . . . featured book **categories** 110 and featured **book** titles 120." Spiegel, column 7, lines 6-8. Moreover, according to Spiegel, "[t]he featured **books** and **categories** are displayed as respective hyperlinks that provide a direct path to the corresponding **books** and **categories**." *Id.* at column 7, lines 17-19. Furthermore, the cited text of Spiegel states that "[e]ach node [of the browse tree] is . . . displayed . . . as a hyperlink (see FIG. 1A)" and "[s]election of a node (hyperlink) causes the children of the node to be displayed." *Id.* at column 4, lines 61-65. Therefore, according to Spiegel, each hyperlink shown in FIG. 1A of Spiegel is simply a **link to a corresponding book or category** in the browse tree, none of which are described in Spiegel as being associated with a **search term**, much less a **frequently used search term**. Spiegel is entirely silent with respect to a frequently used search term, as recited in the context of claim 15. As a result, Spiegel fails to disclose **providing a link to listings associated with a frequently used search** term. Thus, Spiegel does not disclose at least this element of claim 15.

Because **each and every element** of independent claim 15 is not set forth in the cited reference, as arranged in the claim, and in as complete detail as in the claim, no *prima facie* case of anticipation is established. For at least these reasons, independent claim 15 and its dependent claims 16-22 are patentable over the cited reference. Moreover, the dependent claims may each be patentable based on elements recited therein. Thus, Appellants respectfully request that these rejections be reversed and that the claims be allowed.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37
Serial Number: 10/666,681
Filing Date: September 18, 2003
Title: PRODUCT RECOMMENDATION IN A NETWORK-BASED COMMERCE SYSTEM

Page 13
Dkt: 2043.093US1

SUMMARY

In brief, Spiegel fails to disclose at least two elements of independent claim 15 and its dependent claims. Spiegel contains no mention of **identifying a frequently used search term**, and Spiegel is silent with respect to **providing a link to listings associated with the frequently used search term**. For at least these reasons, each and every element of independent claim 15 is not set forth in Spiegel, as arranged in the claim, and in as complete detail as in the claim. As result no *prima facie* case of anticipation is established with respect to independent claim 15 and its dependent claims 16-22. Thus, Appellants respectfully request that these rejections be reversed and the claims be allowed.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this __4th__ day of December, 2009

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8. CLAIMS APPENDIX

15.   A method of providing listing recommendations to users of a network-based commerce system including a plurality of listings arranged in a plurality of divisions, the method including:

identifying a division of the plurality of divisions based on user interaction with the network-based commerce system;

identifying at least one frequently used search term associated with the identified division; and

providing a link to the user to listings associated with the at least one frequently used search term.

16.   The method of claim 15, including communicating a web page to the user including a hyperlink to the listings associated with the at least one frequently used search term.

17.   The method of claim 15, wherein the listings associated with each frequently used search term are listings that would be located if the user conducted a search of the network-based commerce system using the at least one frequently used search term.

18.   The method of claim 15, wherein the at least one frequently used search term is ranked in one of an ascending and descending order according to a number of occurrences of listings in a division associated with the at least one frequently used search term.

19.   The method of claim 18, including periodically adding new listings and removing terminated listings prior to determining the number of listings in each division associated with each frequently used search term so that the ranking is dependent upon supply and demand for the listings.

20.   The method of claim 15, including searching the network-based commerce system using at least one frequently used search term when the user selects the link.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37
Serial Number: 10/666,681
Filing Date: September 18, 2003
Title: PRODUCT RECOMMENDATION IN A NETWORK-BASED COMMERCE SYSTEM

Page 15
Dkt: 2043.093US1

21.   The method of claim 15, wherein the at least one frequently used search term is displayed according to rank in one of an ascending and descending order.

22.   The method of claim 15, wherein one or more frequently used search terms are assigned to each of the plurality of divisions, the divisions being defined by categories.

9. EVIDENCE APPENDIX

None.

10. RELATED PROCEEDINGS APPENDIX

None.